

REMARKS

Claims 1-41 were presented for examination, and the Examiner has required restriction between allegedly distinct inventions of Groups I-VII. The applicants hereby elect the invention of Group II with traverse. The elected Group II encompasses compounds of claims 29-30.

Election of a species was also required by the Examiner, and the applicants elect the compound of Example 20 on page 41 of the specification, which is within the scope of claims 1-10, 12-28, 30, 32-33 and 39.

The restriction requirement is traversed for separating Group VI, including claims 34-35, from the compound and pharmaceutical composition claims. Claims 34-35 are composition claims that depend from and thus include all limitations of claim 33, and add an additional therapeutic agent. Accordingly, they include all limitations of the compounds of the election. The search and examination of the compounds of claim 1 ensures that claims 33-35 are novel and patentable over all prior art. No additional searching is needed, thus there should be no undue burden for the Office to examine these additional claims concurrently.

In support of creating a separate Group VI for these claims, which add an additional therapeutic agent to the pharmaceutical composition of claim 33, the Examiner argued that “patentability of a multiple component composition depends on the individual ingredient and their quantitative relationship which is not coextensive with the patentability of compounds *per se*.” This, however, does not show that any ‘undue burden’ is imposed on the office, nor has the Examiner provided evidence that any burden would be imposed. Because these claims are limited to compositions containing a compound of the elected invention, the examination of the elected compounds ensures that these claims are patentable over all prior art regardless of the identity or

relative proportions of any added ingredients. Accordingly, the applicants request reconsideration and withdrawal of this aspect of the restriction requirement, and examination of claims 34 and 35 along with the invention of Group II.

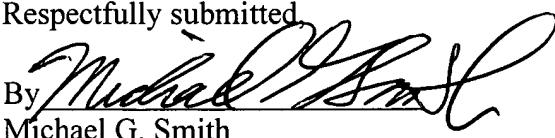
Claim 1 has been amended to correspond to the elected Group II description. Claim 11 has been amended to correct a typographical error. Claims 31, 40 and 41 were canceled. Claims 36-38 were withdrawn in keeping with the election of Group II.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 219002029600.

Dated: November 17, 2006

Respectfully submitted,

By 
Michael G. Smith

Registration No.: 44,422
MORRISON & FOERSTER LLP
12531 High Bluff Drive, Suite 100
San Diego, California 92130-2040
(858) 720-5113